

REMARKS

The above Amendments and these Remarks are in reply to the Office action mailed 14 April 2010.

Claims 1 and 3-105 were pending in the Application prior to the outstanding Office Action. The present Response amends claims 100, 102, 105; cancels claims 101, 103; leaving for the Examiner's present consideration claims 1, 3-100, 102, 104, 105. Reconsideration of the rejections is requested.

I. RESULTS OF TELEPHONE INTERVIEW OF JULY 13, 2010

Examiner Topgyal and SPE Thai Tran are thanked for their telephone interview with the undersigned on July 13, 2010. In the interview, agreement was reached that the rejections of independent claims 74 and 93 and their respective dependent claims would be withdrawn. The rejections of independent claims 1, 45, 92 and 104 were also discussed, but no agreement was reached. Examiner Tran asked that Applicants' points regarding these claims be written up in a Response so that they may be considered in more detail. Applicants do so below.

II. REJECTIONS UNDER 35 U.S.C. § 103(a)

Claims 1 and 3-105 are variously rejected under 35 USC 103(a) citing Watanabe, Kaltenecker, Wakui, Ando, Jones, Jeong, Torres and Falcon in various combinations.

Applicants will address the independent claims first, followed by the dependent claims.

A. Independent Claim 1

Claim 1 calls for a portable memory device that includes memory and a display, a communications interface for establishing a communication link between the memory device and different hosts, one of which comprises a digital camera device. The card also includes a controller operable, in response to user input, to store an image in the memory, render an image on the display, and "transform an image in the memory from a first image file format to a second image file format."

The Office action cites Watanabe as teaching all these limitations except the ability of the portable memory device to "transform an image in the memory from a first image file format to a second image file format." The Office action cites Kaltenecker as teaching that element.

Kaltenecker teaches a system in which a document is scanned to image data and converted to other file formats for storage. The image capturing system can for example be a scanner, digital camera, or a digital video camera/recorder (Kaltenecker 3/58-61), and the file formats may include for example, FPX, GIF, JPEG, PDF, etc. (Kaltenecker 7/64-8/1).

The motivation given in the Office action to combine Watanabe with Kaltenecker is "to allow for the second host to be able to view the image of the first format".(OA, p.4)

However, Watanabe's main purpose in making his display removable from the camera, with an image display, is so that the images can be viewed without separate playback apparatus. See the following excerpts from Watanabe, for example:

"Since the memory cartridge possesses an image data playback function, an image can be played back without separately providing a playback apparatus." (2/17-21).

"Since the memory cartridge possesses an image data playback function, an image can be played back without separately providing a playback apparatus." (2/38-42).

"Thus, the memory cartridge 20 is not only a recording medium for image data but also functions as a playback device. This is convenient in that the image playback can be performed in a simple fashion without loading the memory cartridge in a separately provided playback apparatus." (8/27-32).

Therefore, it appears that this purpose in Watanabe, to preclude any need for separate playback apparatus, contradicts the motivation given in the Office action for combining it with Kaltenecker - to allow for a second host to be able to view the image on the card. A skilled person reading Watanabe and Kaltenecker would not have considered combining them in order to allow for a second host to be able to view the image on the card, because avoidance of any need for a second

host is precisely Watanabe's reason for a removable card that displays its own images.

During the interview, Examiner Tran indicated that the motivation to combine arises because a person would be motivated to extend Watanabe's display-on-card to enable printing the images, and Kaltenecker teaches conversion of an image file format for printing purposes (among other things).

However, Applicants again refer the Examiner to the above-quoted sections of Watanabe in which he extols the virtues of being able to view the image without having to load the memory cartridge in a separately provided playback apparatus. Since printing would clearly require separately provided playback apparatus (i.e. a printer), again the Examiner's proposed motivation is exactly contradicted by Watanabe's teachings.

Moreover, neither motivation cited above explains why a person of ordinary skill would have been motivated to put the image file format conversion capability on the same memory card that carries the image data and the display, as called for in Applicants' claim. During the interview, the Examiner said he is not citing Kaltenecker for the teaching that the image format conversion capability should be provided on the card, but rather only for the proposition that Watanabe can be expanded on by providing image format conversion capability so that second hosts can also process image for display or print.

Applicants submit that is not enough of a teaching to find Applicants claims obvious. Watanabe has two pieces: a camera and a memory card. Even if Kaltenecker teaches the ability to expand on a system by providing image format conversion capability (which, again, Applicants dispute), the Examiner still has not cited a reference that this image format conversion capability should be on the memory card and not in the camera. Why would the skilled person been motivated to place this capability on the memory card? Why would he not have instead placed it in the camera, where there was more room? The Office action does not appear to cite any motivation for that aspect of the combination. And again, why would the skilled person have been motivated to place the image format conversion capability on the memory card, specifically when that combination would undermine the benefits that Watanabe extols about his invention?

Finally, the Examiner pointed out during the interview that Kaltenecker mentions that his image capturing device 17 could be a digital camera as opposed to a scanner. (3/59). However,

Kaltenecker also says, when discussing possible variations of his invention, that his file conversion system "could be implemented by an image-capturing system 16, digital cameras, digital video cameras/recorder, etc." (8/50-54). This laundry list of variations occurs at the end of Kaltenecker's specification, just before the claims, where inventors often list all the major variations they can think of. Yet even here, he still does not mention that the file format conversion could or should be implemented on a memory card of the digital camera. Kaltenecker's omission of a memory card, in his laundry list of places where his image file format conversion could be implemented, implies that he had no concept at all that it could be implemented on the memory card. Certainly he did not *teach* this feature, and a person of ordinary skill would not have learned that feature from reading Kaltenecker.

Applicants would like to point out that Watanabe's clear purpose to avoid any need for separate playback apparatus, teaches away from any combination in which a goal is to enable his memory card to be used with separate playback apparatus. It simply would not have been obvious, in light of Watanabe's clear teachings, to enhance his memory/display card with any image file format conversion capability. No motivation to do so has yet been explained by the Office, other than motivations that directly contradict Watanabe's clear purpose.

Accordingly, Applicants respectfully submit that claim 1 should be patentable both because the Office action fails to recite any reference teaching a file format conversion capability on the memory card, and also because no motivation has yet been cited by the Office to combine Kaltenecker, which does not directly contradict Watanabe's clear purpose.

Claim 1 therefore should be patentable.

B. Independent Claims 45, 92 and 104

These claims all include limitations similar to that in claim 1, that the memory card include a controller or control means operable to transform an image in the memory from a first image file format to a second image file format.

Accordingly, these claims should be patentable for at least the same reasons as set forth above with respect to claim 1.

These claims each also add their own additional limitations which should render them

patentable in their own right.

Claim 92, for example, further calls for the portable memory device to also support "a receptacle for receiving a further memory device removable from the portable memory device." The claim calls for the controller to store the image from the first host in memory of the further memory device, render on the display an image from the further memory device, and "transform an image in the memory of the further memory device from a first image file format to a second image file format".

The Office action does not cite any reference that teaches these limitations regarding the receptacle, the further memory device, and the operations on the further memory device. Accordingly, claim 92 should be allowable for these reasons as well.

Accordingly, independent claims 45, 92 and 104 should be patentable.

C. Independent Claims 74 and 93, and Dependent Claims 75-91 and 94-99

Independent Claims 74 and 93 each include a limitation calling for the controller on the card to be operable to "detect from communication with a second one of the hosts, a second image file format suitable for the second host".

During the interview, the Examiner agreed that neither cited reference teaches this feature and indicated that he will withdraw the rejections of these claims.

Accordingly, Applicants believe these claims, and their respective dependent claims 75-91 and 94-99, should be patentable.

D. Independent Claims 100, 102 and 105, and Dependent Claims 101 and 103

These claims each have been amended to incorporate the limitation that the controller be operable to "transform an image in the memory from a first image file format to a second image file format." As such, they should all be patentable for the same reasons as set forth above with respect to claims 1, 45, 92 and 104.

Dependent claims 101 and 103 have been canceled to conform with the amendments to claims 100 and 102.

E. Dependent Claims 3-44 and 46-73

The Examiner rejected these claims as being obvious over various combinations of Watanabe and Kaltenecker and one of Wakui, Ando, Jones, Jeong, Torres and Falcon.

These claims all depend ultimately from independent claim 1 or 45, and therefore are believed to be patentable for at least the reasons set forth above with respect to independent claim 1. In addition, these claims each add their own limitations which, it is submitted, render them patentable in their own right. Applicants respectfully disagree with many of the positions taken in the Office Action with respect to these claims, and reserve the right to point out their reasons should it become necessary in the future.

III. SUBSTANCE OF INTERVIEW

This section sets forth Applicant's Substance of Interview.

1) A brief description of the nature of any exhibit shown or any demonstration conducted:

None

2) An identification of the claims discussed:

Claim 1, 45, 74, 92, 93 and 104.

3) An identification of the specific prior art discussed:

Watanabe and Kaltenecker.

4) An identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner.

No amendments were proposed in the interview.

5) A brief identification of the general thrust of the principal arguments presented to the examiner:

As set forth herein.

6) A general indication of any other pertinent matters discussed:

None.

7) If appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner:

As set forth herein.

IV. OTHER MATTERS AND CONCLUSION

In light of the above, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and a Notice of Allowance is requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

The claim amendments made herein are made without prejudice to Applicants' right to pursue different or broader claims later.

The appropriate extension of time fees are being submitted herewith.

Applicants believe no other fee is due with this response. However, the Commissioner is authorized to charge any fee or credit any overpayment related to the present submission to our Deposit Account No. 50-0869, under Order No. JMZ 1000-1US from which the undersigned is authorized to draw.

Respectfully submitted,

Dated: 3 August 2010

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